

REMARKS

Claim Rejections - 35 U.S.C. § 112 and Specification Objection

The amendment filed 1/14/2008 is objected to under 35 U.S.C. 132(a) because it allegedly introduces new matter into the disclosure. The added material which is not allegedly supported by the original disclosure is found in claims 6, 10, and 11.

Claims 6, 10, and 11 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse these rejections and objections.

The Examiner alleges that claims 6, 10, and 11 contain new matter which is missing from the application as originally filed. Applicants submit that the specification is clear in that the corrected image data and image data are transmitted together to the image recording section. Furthermore, FIG. 5 and FIG. 6 clearly depict the simultaneous and sequential transmission of the corrected image data and image data.

Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. 112, first paragraph rejection and the 35 U.S.C. 132(a) specification objection.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner alleges that in claim 1, the phrase “records at least either one of a set of image and information capable of reproducing the original image and the original image on a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data”, does not “make any sense” to the Examiner.

Applicants submit that “a set of image and information capable of reproducing the original image and the original image” refers to being able to reproduce the original image from the image and information stored in the media. The claims specify printing or storing uncorrected images to a first medium (print or data) and printing or storing corrected images to a

second medium without being unduly limiting to the claims and are therefore sufficiently clear. Thus the terminology used in the independent claims are sufficiently clear and the claims meet all requirements of 35 U.S.C. § 112 second paragraph.

Accordingly, Applicants request that the Examiner withdraw the 35 U.S.C. 112, second paragraph rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White et al. (U.S. 7,035,462; hereinafter "White") in view of Shiota et al. (U.S. 6,345,998; hereinafter "Shiota"). Applicants respectfully traverse these rejections.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shiota in view of White. Applicants respectfully traverse these rejections.

Claim 5

Claim 5 recites, in part, "the image correcting section transmits the corrected image and image data together to the image recording section". The Examiner asserts that the image handling apparatus 15 of Shiota discloses the image correcting section and image recording section, and that the image handling apparatus 15 transfers corrected image and image data as required in claim 5. Applicants disagree with the Examiner's position

In Shiota, the image handling apparatus 15 is a general purpose computer with dedicated software installed. (See col. 10, lines 53-55). The Examiner argues that a computer with the proper software programming and hardware discloses "the image correcting section" of the claimed invention. The Examiner's reliance on FIG. 8, general purpose computer 15, however, is too general to teach the specific elements of claims 5. FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together in Shiota as described in claim 5 of the present invention.

Furthermore, Shiota, only discloses transferring *processed* image data. (See col. 11, lines 1-5). As a result, Shiota does not disclose that the image handling apparatus 15 contains the proper software and hardware to “transmit *both* the corrected image and *image data*”. Thus Shiota does not disclose or suggest that “the image correcting section transmits the corrected image and image data together to the image recording section” as recited in claim 5.

Claim 6

For the same reasons that claim 5 is patentable over the prior art, claim 6 is also patentable over the prior art. Furthermore, Shiota does not overcome the deficiencies noted above in the teachings of White.

Claims 7 and 8

Claim 7 recites, in part:

the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data.

The Examiner asserts that, “printing the red eye corrected image of White using the printer 5 shown in Figure 1 of Shiota and by storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota” would have been obvious “for the benefit of increasing efficiency”. Applicants disagree with the Examiner’s position.

Claims 7 and 8 describe alternative printing or data storage of corrected and original data. However, it is clear from FIG. 2, that all data stored or printed in Shiota is corrected data. Shiota does not allow for the uncorrected data processes as described by claims 7 and 8.

Further, Applicants respectfully submit that one of ordinary skill in the art at the time of the presently-claimed invention would not have been motivated to combine White and Shiota as

suggested by the Examiner because there is no suggestion of motivation for doing so in the references themselves or the knowledge available to one of ordinary skill in the art without resorting to impermissible hindsight.

Shiota discloses in FIG. 2 that all data stored or printed is processed data (corrected data). Alternatively, White teaches correcting for eye color defects but does not disclose storing an original image. (See Abstract). The Examiner asserts that, “storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota” would have been obvious “for the benefit of increasing efficiency”. However, FIG. 2 of Shiota teaches that all images stored in element 6 are processed data (corrected data). Thus, Shiota does not allow for the uncorrected data (original image) processes as described by claims 7 and 8. Because of the disparity between these two references, the only possible motivation for the Examiner’s proposed combination is Applicant’s own disclosure, the reliance on which constitutes impermissible hindsight reconstruction under MPEP §2143 (see also *In re Vaeck*, 20 USPQ 1438 (Fed. Cir. 1991)).

Claim 9

Claim 9 recites, in part, “an image correcting section that... transmits the corrected image data and original image data together to the image recording section”. The Examiner maintains that Shiota discloses transmitting the corrected image data and original data together in citing FIG. 1 and FIG. 8. Applicants disagree with the Examiner’s position.

FIG. 2 of Shiota, shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together as described in claim 5 of the present invention, and Shiota does not disclose or suggest “transmits the corrected image data ***and*** original image data ***together***” as recited in the claimed invention.

Claim 9 also recites, in part:

a recording of corrected image data as electronic data, said image recording means for further recording one of a) the image data capable of reproducing the original image and b) the original image onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data.

The Examiner maintains that FIG. 1 and disk 6 of Shiota discloses the above recited features.

Applicants disagree with the Examiner's position.

Shiota discloses that *the processed image* is stored on the recording medium 6. (See col. 11, lines 2-5). Shiota does not allow for the uncorrected data processes as described by claims 9. Thus, Shiota does not disclose or suggest an "image data *capable of reproducing the original image*", or "*the original image* onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data," as recited in the claimed invention.

Claims 10 and 11

Claim 10 recites in part, "image correcting section transmits the corrected image and image data simultaneously to the image recording section". Claim 11 recites in part, "the image correcting section transmits the corrected image and image data sequentially to the image recording section". The Examiner asserts that both claims 10 and 11 are disclosed in FIG. 8 of Shiota. Applicants disagree with the Examiner's position.

FIG. 8 of Shiota shows a computer connected to a printer 5 and storage medium 6. Shiota, however, is silent on whether the data is transmitted together to the printer 5 and storage medium 6. (See col. 11, lines 1-5). But, FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted simultaneously or sequentially in Shiota as described in claims 10 and 11 of the present invention.

Applicants also submit that the Examiner has cited the same reference and elements in Shiota as anticipating both claims 10 and 11. Assuming *arguendo*, that Shiota does disclose transmitting the corrected image and image data together to the printer and storage medium, it would not follow that Shiota would also disclose both the simultaneous and sequential transmission of corrected image and image data. Thus, Applicants submit that the same Shiota reference and citations could not disclose both claims 10 and 11.

Claim 12

For the same reasons that claim 7 is patentable over the prior art, claim 12 is also patentable over the prior art as claim 12 recites similar elements.

Claim 13

For the same reasons that claim 8 is patentable over the prior art, claim 13 is also patentable over the prior art as claim 13 recites similar elements.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being allegedly anticipated by White. Applicants respectfully traverse these rejections.

The Examiner has recited the exact rejection in the present Office Action as was previously recited in the Office Action dated September 14, 2007. Therefore, the arguments presented are limited to the Examiner's Response to Arguments found on pages 10-11 of the present Office Action.

Examiner's Response to Arguments

Claim 1

The Examiner asserts that "the output image from printer 61 of figure 10" and "column 14, the pixel information can be the corrected pixel information and/or the pixel information

previous to being corrected and stored in external media such as memory card 28 as shown in block 126 of figure 11” of White as disclosing:

an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media for recording an image in a form of either one of an image recording on a visual basis *and* a recording of image data, and records either one of a set of image and information capable of reproducing the original image and the original image onto a second external media for recording an image in form of either one of an image recording on a visual basis and a recording of image data.

As argued in Applicants’ Amendment dated January 14, 2008, Applicants submit that White fails to disclose the recording of “corrected image” to “a first external media”; or “either one of a set of image and information capable of reproducing the original image and the original image” to “a second external media” of the claimed invention. The “pixel information” as it pertains to White, refers to software code. In particular, the Examiner’s citation to col. 14 teaches metadata which includes the pixel information attached to the digital file of the image, which at best implicates storage of both the corrected image and data to “undo” the corrected image, to a single medium. (See col. 14, lines 1-2 and 12-15). As such, the White reference does not disclose or suggest storing the original image onto the second external media, or “a set of image and information capable of reproducing the original image” as recited in the claimed invention. Furthermore, it is clear from the claim language of the present invention that the “corrected image” is separate from “a set of image and information” whereas in White, the metadata to undo the corrections are attached to the corrected image file. Since the Examiner has not established that the applied reference includes each and every feature of the claimed invention, the White reference is not properly a § 102 reference. Thus, claim 1 should be patentable over the applied art.

Accordingly, claims 2-4 should be patentable at least by virtue of their dependency from claim 1.

Claim Rejections - 35 U.S.C. § 103

Claim 4 is rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White. Applicants respectfully traverse this rejection.

The Examiner has recited the substantially same rejection in the present Office Action as was previously recited in the Office Action dated September 14, 2007, with the only difference is in citing *KSR Int'l v. Teleflex Inc* in support of the Examiner's Obviousness rejection. Therefore, the arguments presented are limited to the Examiner's Response to Arguments found on pages 11-12 of the present Office Action and the Examiner's new case history citation in support of the obviousness rejection.

Examiner's Response to Arguments

Claim 4

As argued in Applicants' Amendment dated January 14, 2008, Applicants submit that White fails to disclose:

the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print.

The Examiner asserts:

White discloses printing images on paper using printer 61. Column 1 of White discusses printing the uncorrected red eye photographs, which can be achieved by White in box 218 of figure 11 by selecting no red eye correction, or by simply printing the red eye photograph without performing red eye correction. Printing the red eye corrected image can be achieved by White by performing the red eye correction process of figure 11 and printing the red eye corrected version of the image. Thus, a user who prints an image with printer 61 before using the red eye correction process, then prints an image with printer 61 after using the red eye correction process, would have the original and the red eye correction photographic prints of the image.

Assuming, arguendo, that the Kiosk 60 of White is capable of performing the functions asserted by the Examiner, such a process would be at odds with the claimed invention. The Examiner argues for the combination of elements in White, and asserts a method of implementing White to disclose the present invention. Such a combination of elements as proposed by the Examiner, however, would prevent the present invention to function as claimed in claim 4. As shown in Fig. 11 and admitted by the Examiner, either the corrected or uncorrected image is stored and printed. Such an implementation of White is counter to claim 4 as both the corrected and uncorrected images are printed. The Examiner asserts that it would be obvious to implement the decision making process of Fig. 11 twice to correspond to claim 4 because the combination is the predictable use of printing a corrected image onto a print followed by the predictable use of printing the original image onto a print. Such an assertion, however, is based on the Examiner viewing the White reference with the benefit of hindsight vision afforded by the claimed invention. The Examiner is assuming more than just “whether the improvement is more than the predictable use of prior art elements according to their established functions.” See *KSR Int’l v. Teleflex Inc.* 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007).

White teaches printing the images one at a time. (See Fig. 11). White, however, does not teach or suggest photographic prints of both the corrected image, *and* the set of image and information or the original image. Thus, White does not disclose or teach, “the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print” of the claimed invention.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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